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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,697	04/09/2004	Robert P. Bishop	31141-101	1539
26486	7590	11/20/2006	EXAMINER	
BURNS & LEVINSON, LLP (FORMERLY PERKINS SMITH & COHEN LLP) 125 SUMMER STREET BOSTON, MA 02110			DREIDAME, HUNTER M	
			ART UNIT	PAPER NUMBER
			3635	

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/821,697

Applicant(s)

BISHOP, ROBERT P.

Examiner

Hunter M. Dreidame

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 - 20 is/are pending in the application.
- 4a) Of the above claim(s) 3, 5, 9, 16, 17, 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 6 - 8, 10 - 15, 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 08/23/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: Exhibit A.

**DETAILED ACTION*****Claim Status***

Applicant has elected Species I, which corresponds to Fig. 1. Applicant cites claims 1, 2, 4, 6, 7, 8, 10, 11, 12, 13, 14, 15, and 18 as reading on the species. Therefore, claims 3, 5, 9, 16, 17, 19, and 20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected embodiments in Figs. 2A – 2F, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 11/02/2006.

***Oath/Declaration***

It does not identify the mailing address of each inventor. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing address should include the ZIP Code designation. The mailing address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

***Specification***

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Removable Tie-Down Clip.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 11, line 11 discloses an element composed of "high-strength" material. "High-strength" is considered vague and indefinite.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 6 – 8, 10 – 14, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,210,912 to Hoefkes.

Claim 1:

Hoefkes discloses a clip (Fig. 1) capable of securing objects to a surface formed of spaced-apart surface members of substantially uniform thickness, comprising a head (10, Fig. 1) defining a substantially contiguous aperture (22, Fig. 1) adapted to receive connectors to an object and having a maximum dimension greater than the spacing between the surface members; a pair of legs (24, Fig. 1) extending from the head, the legs each dimensioned to fit in the spacing between the surface members and to traverse the thickness of the surface members; and a pair of feet (26', 28, Fig. 1) one each extending from

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each one of the pair of legs, the feet diverging in opposite directions to a distance greater than the spacing between the surface members.

Claim 2:

The clip of claim 1, wherein the legs are substantially co-planar with the head (Fig. 1).

Claim 4:

The clip of claim 1, wherein the feet are substantially co-planar with the head (Fig. 1).

Claim 6:

The clip of claim 1, wherein the head, the pair of legs, and the pair of feet are formed in a single element (Fig. 1).

Claim 7:

The clip of claim 6, wherein the single element comprises a wire (lines 8 – 11, col. 1).

Claim 8:

The clip of claim 1, wherein the legs are inherently spring-loaded to separate from one another, as the clip may be formed of steel (lines 35 – 36, col. 1; see Exhibit A for elastic modulus of steel).

Claim 10:

The clip of claim 1, wherein the head is formed in a shape selected from the group consisting of rings, ellipsoids, and multi-sided shapes (Fig. 1).

Claim 11:

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The clip of claim 1, wherein the element is composed of a high-strength, corrosion resistant material (lines 35 – 36, col. 1).

Claim 12:

The clip of claim 11, wherein the material is selected from the group consisting of stainless steel, brass, aluminum, and plastic (lines 8 – 11, 35 – 36, col. 1).

Claim 13:

The clip of claim 1, wherein the clip is composed of a spring-tempered material (lines 35 – 36, col. 1; see Exhibit A for elastic modulus of steel).

Claim 14:

The clip of claim 13, wherein the legs are compressible to a position within the spacing between the surface members such that the feet diverge in separate planes substantially parallel to a plane including the head (Fig. 1).

Claim 18:

The clip of claim 1, wherein the feet diverge in a curve-like geometry (Fig. 1).

Claims 1 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by US Design Patent 29,041 to Thomas.

Claim 1:

Thomas discloses a clip (Fig. 1) capable of securing objects to a surface formed of spaced-apart surface members of substantially uniform thickness, comprising a head (A, Fig. 1) defining a substantially contiguous aperture (Fig. 1) adapted to receive connectors to an object and having a maximum dimension

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greater than the spacing between the surface members; a pair of legs (A', B, Fig. 1) extending from the head, the legs each dimensioned to fit in the spacing between the surface members and to traverse the thickness of the surface members; and a pair of feet (C, Fig. 1) one each extending from each one of the pair of legs, the feet diverging in opposite directions to a distance greater than the spacing between the surface members.

Claim 15:

The clip of claim 1, wherein the feet diverge in substantially straight, diametrically opposed directions (Fig. 1).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hunter M. Dreidame whose telephone number is (571)272-5177. The examiner can normally be reached on Monday - Friday 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on (571)272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



HD



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